

Remarks

New claims 13-16 are added. Support for these claims is in the specification at page 9, lines 1-5.

Concerning the rejection under 35 USC 102(b), all the claims now specify three elements, namely a clamp body, a strap disposed entirely around the exterior of the clamp body, and a radially acting spring. The claims are thus not anticipated by Daghe et al (Daghe hereinafter) which shows only a band means 12 but not any completely encircling strap.

Concerning the rejection under 35 USC 103(a), the Examiner has argued that motivation to combine Daghe and GB 649 would have come from a requirement to protect the clamp body. One problem with this argument is that the Examiner has not qualified himself as an expert in this field and, absent such qualification, the Examiner can not offer his opinion in place of prior art evidence. Nothing in the references of record shows or suggests that the body of GB 649 requires protection.

Another problem with the rejection under 35 USC 103(a) is that it is not in accord with two examination guidelines provided in the MPEP. Thus, in section 2143.01V, it is explained that the proposed modification cannot render the prior art unsatisfactory for its intended purpose, and in 2143.01V1, it is explained that the proposed modification cannot change the principle of operation of a reference. The present rejection violates both guidelines.

Daghe discloses only that his clamp be used for sealing leaks in pipes and provides a gasket G to accomplish this. Using the Dagny gasket as proposed by the examiner involves a significant change in function of the Dagny clamp. It is not used for sealing purposes and, indeed, it is so positioned on the pipe as to be entirely unable to perform its intended function. The

examiner takes support from the fact that both the gasket and the spring of applicants' invention are of rubber and that the Daghe gasket can likely perform the function of the claimed spring. A problem with this argument however, is that to persons of skill not aware of applicants' invention, the use of the rubber gaskets for purposes other than sealing leaks is not self evident.

The examiner also observes that the band 12 of Daghe is equivalent to the band 7 of GB 649 thus justifying the use of the gasket G in the modified clamp of GB 649. A shortcoming of this argument, however, is that the band 12 of Daghe is more equivalent to the GB band without the gasket than with it.

It is noted that certain ones of the new claims specify that the spring is disposed inboard of the clamp body, hence not between the clamp body and the strap. Accordingly, the spring can not perform the function of protecting the clamp body from the strap, and the motivation proposed by the examiner for combining the two patents does not apply against these claims.

Reconsideration of the rejections of the claims and allowance of the application are respectfully requested.

Respectfully submitted,



Michael Y. Epstein

Reg. No. 21186